



UNITED STATES PATENT AND TRADEMARK OFFICE

W

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,068	03/25/2004	Vincent Mutel	20856US2	6997

151 7590 10/21/2004

HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY, NJ 07110

EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/809,068	Applicant(s) MUTEL ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/093,790.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1625

DETAILED ACTION

1. Claims 1-11 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 recites the limitation "method" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

4. Claims 3-7 recite the limitation "composition" in claim 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (U.S. Patent 3,701,780, cited on applicants form 1449).

Fisher discloses Imidazopyridines having anthelmintic and fungicidal activity and pharmaceutical compositions containing these compounds. The pharmaceutical compositions containing exemplified compounds of examples 3, 7 and 8 disclosed by Fisher anticipate the instant claims when A represents a heteroaryl group in the instant compounds of formula I.

6. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Andreani (Eur. J. Med. Chem., cited on applicants form 1449).

Andreani discloses cardiogenic activity (pharmaceutical utility) of aryl- or pyridyl-substituted fused imidazoles. The compounds 3a, 3b and 3c (see page 339 and table

111 on page 342) disclosed by Andreani anticipate the instant claims when A represents phenyl or heteroaryl group in the instant compounds of formula I.

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (JP 11-116481, cited on applicants form 1449).

Inoue discloses pharmaceutical utility of Imidazolepyridine derivatives for treating autoimmune, viral and bacterial diseases. The compounds disclosed on pages 9-12 by Inoue anticipate the instant claims when A represents aryl group in the instant compounds of formula I.

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Raj (IN 179790).

Raj discloses novel 2-substituted imidazopyridines and their pharmaceutical utility for having antifertility activity. The compounds disclosed in examples 3 and 4 (see pages 4 and 5) anticipate the instant claims when A represents aryl group in the instant compounds of formula I.

9. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Raj (IN 179788).

Raj discloses novel 2-substituted imidazopyridines and their pharmaceutical utility for having antifertility activity. The compounds disclosed in examples 1-4 (see pages 4-6) anticipate the instant claims when A represents aryl group in the instant compounds of formula I.

Art Unit: 1625

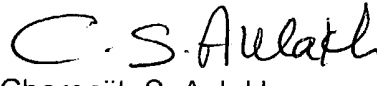
Allowable Subject Matter

10. Claims 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
Art Unit 1625